

REMARKS

I. Rejections Under 35 U.S.C. § 112

The rejections are overcome by the amendments.

II. Rejections Under 35 U.S.C. § 103

Claims 1, 4, 5, 7, 10, 15, 16 and 18 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Backensfeld et al. (U.S. Patent No. 798,338).

Applicants disagree with the rejection but to further the prosecution of this application amend the claims so that they are directed to compounds that have a hydroxyketone side chain. This feature was present, for example, in now cancelled claim 17, which was not rejected here.

Claims 1-5, 7, 10, 11, 13-16, 15-20 and 22 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Backensfeld et al. (U.S. Patent No. 798,338) in view of Schollkopf et al. (WO 96/20209). Applicants respectfully traverse this rejection.

Even if the Examiner were correct regarding the teachings of the references, which is not admitted, this does not make the present claims obvious. The possibility of using cyclodextrins with estrogens says nothing with regard to the effect of cyclodextrins on gestagens with a hydroxyketone side chain. Thus, there is no motivation for the claimed combination.

Although not necessary, applicants submit data demonstrating the effect of β -cyclodextrin on the degradation of a compound (ZK 187226) according to the invention. In the control HPLC chromatogram where ZK 187226 is in a tablet without β -cyclodextrin, peaks for the acyloin rearranged degradation byproducts are also present, whereas in the chromatogram where the ZK 187226 is in a tablet with β -cyclodextrin, no peaks are present for the acyloin rearranged degradation byproducts. A declaration to this effect will be submitted in the near future.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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